REMARKS

I. Status of the Claims

In the Office Action mailed on April 30, 2008, the Examiner rejected claims 1-16 under 35 U.S.C. § 112, second paragraph; rejected claims 1, 32, and 63 under 35 U.S.C. § 102(b) as being anticipated by *Hoffman* (U.S. Patent No. 5,297,026); rejected claims 2-14, 33-45, and 64-76 under 35 U.S.C. § 103(a) as being unpatentable over *Hoffman* in view of *Oncken* (U.S. Patent No. 4,985,833); and rejected claims 15, 16, 46, 47, 77, and 78 under 35 U.S.C. § 103(a) as being unpatentable over *Hoffman* in view of *Oncken* and *Halbrook* (U.S. Patent No. 5,987,436).

By this amendment, Applicants amend claims 1, 32, and 63, and cancel previously withdrawn claims 17-31, 48-62, and 79-93 without prejudice or disclaimer. By amending these claims, Applicants do not accede to any of the outstanding rejections. To the contrary, Applicants respectfully traverse the rejections contained in the Office Action. Claims 1-16, 32-47, and 63-78 remain pending and under current examination.

II. Rejections under 35 U.S.C. § 112

In the Office Action, the Examiner rejected claims 1-16 under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner alleges that "[i]t is unclear who or what is performing the 'receiving' and the 'determining' steps." Applicants respectfully traverse the rejection.

Claims 1-16 are method claims. In particular, claim 1 recites "[a] method, performed by a processor." Therefore, the individual steps of method claims 1-16 are

performed by the processor. Accordingly, Applicants submit that claims 1-16 are clear and definite and the rejection of claims 1-16 under 35 U.S.C. 112 should be withdrawn.

III. Rejections under 35 U.S.C § 102(b)

Applicants respectfully traverse the rejections of claims 1, 32, and 63 under 35 U.S.C. § 102(e) because *Hoffman* fails to disclose each and every element of Applicants' claims.

Amended independent claim 1 recites a method, performed by a processor, for funding a financial institution through a financial investment fund, the method comprising:

> receiving a plurality of individual funds corresponding to a plurality of investors respectively;
>
> aggregating the plurality of individual funds into an aggregated fund for investing into the financial investment fund, wherein the investment fund includes a plurality of certificates of deposits and a transaction account;
>
> determining a first portion of the financial investment fund to invest in the certificates of deposits issued by the financial institution, wherein each certificate of deposit matures at a predetermined time, and wherein the financial institution uses the first portion of the financial investment fund to perform a function of the financial institution; and
>
> determining, based on the amount of the first portion invested in the certificates of deposits, a second portion of the financial investment fund for investing in the transaction account.

Hoffman fails to teach or suggest at least aggregating the plurality of individual funds into an aggregated fund for investing into the financial investment fund, wherein the financial investment fund includes a plurality of certificates of deposits and a transaction account and the determining steps, as recited in amended claim 1.

Hoffman discloses a method for allowing credit card customers to invest a preset portion of charges made using a credit card back with an offering entity (*i.e.*, the credit card issuer or a business accepting purchases by the credit card customer). (*Hoffman*, 1:65-2:15.) For example, "if the customer has purchased $1000 of goods and services from a department store, for example, during a specific billing period . . . and the investment percentage amount is set at 10%, the customer may invest $100 with the offering entity for the period in question." (*Id.* at 4:36-43.) The invested amount is deposited in a deposit account "using a dedicated account number which is tied to the customer." (*Id.* at 4:54-57.) The funds within the customer's deposit account is pooled by the offering entity with other customer accounts and used by the offering entity to make investments. (*Id.* at 5:3-13.) "The offering entity 32 actually invests these investment funds, for example in high return institutional investments 50, which provide a return to the offering entity indicated at arrow 52." (*Id.* at 5:58-61.) *Hoffman* does not teach or suggest "wherein the financial investment fund includes a plurality of certificates of deposits and a transaction account," as recited in claim 1.

In addition, because *Hoffman* does not teach or suggest a financial investment fund that includes both "plurality of certificates of deposits and a transaction account," *Hoffman* also fails to teach or suggest the claimed determining steps. In rejecting claim 1, the Examiner cites to column 3, lines 1-26 and column 4, lines 54-61 of *Hoffman* to allegedly show the claimed determining steps. However, the cited passages merely disclose steps for setting up and managing a deposit account for a customer. The cited passages and the remaining portions of *Hoffman* do not teach or suggest "determining a first portion of the financial investment fund to invest in the certificates of deposits

issued by the financial institution" and "determining, based on the amount of the first portion invested in the certificates of deposits, a second portion of the financial investment fund for investing in the transaction account," as recited in claim 1. Applicants therefore respectfully request the withdrawal of the rejection of claim 1 under 35 U.S.C. 102(b) and the timely allowance of the claim.

Independent claims 32 and 63, while of different scope than claim 1, distinguish over *Hoffman* for at least the same reasons as claim 1.

IV. Rejections under 35 U.S.C § 103(a)

Applicants respectfully traverse the rejections of claims 2-16, 33-47, and 64-78 under 35 U.S.C. § 103(a) because a *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. *See* M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. *See Id.* "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole

would have been obvious." M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

"[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

Dependent claims 2-16, 33-47, and 64-78 include all the elements recited in respective independent claims 1, 32, and 63. As discussed above, *Hoffman* fails to teach or suggest all of the claimed elements, including "wherein the financial investment fund includes a plurality of certificates of deposits and a transaction account," "determining a first portion of the financial investment fund to invest in the certificates of deposits issued by the financial institution," and "determining, based on the amount of the first portion invested in the certificates of deposits, a second portion of the financial investment fund for investing in the transaction account." *Oncken* and *Halbrook*, do not cure the above noted deficiencies of *Hoffman*, nor does the Examiner rely on *Oncken* and *Halbrook* for such teachings. Accordingly, dependent claims 2-16, 33-47, and 64-78 are allowable for at least the same reasons set forth above in connection with claims 1, 32, and 63.

CONCLUSION

The preceding remarks are based on the arguments presented in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The pending claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding remarks in favor of patentability are advanced without prejudice to other bases of patentability. Furthermore, the Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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